

Remarks

This communication is considered fully responsive to the Office Action mailed April 13, 2006 (hereinafter referred to as the "Office Action"). In the Office Action, Claims 1-25 were examined and stand rejected. Claim 18 is amended. No claims are cancelled. No new claims are added. Reexamination and reconsideration of claims 1-25 are respectfully requested.

Claim Rejections - 35 U.S.C. 102

The Office Action rejected claim 18 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,577,907 to Czyszczewski, et al. (hereinafter referred to as "Czyszczewski"). Applicant respectfully traverses this rejection for the reasons stated below.

Claim 18 is amended to recite "program code for automatically determining at least one document property for optimizing output at each of said different types of network destinations, [and] program code for formatting the at least one document property of said document for each of said different types of network destinations" [emphasis added]. Czyszczewski fails to disclose at least these recitations.

The Office Action relies on col. 8, lines 61-64 in Czyszczewski. However, this citation states that "Step E converts the incoming ASCII data into Adobe PostScript data." There is no teaching or suggestion that the multifunction device automatically determines at least one document property for optimizing output. It simply states that the data type is changed.

The Office Action also relies on Figure 9D in Czysczewski as disclosing these recitations. However, this figure shows a user interface where a user can select between PDF and Text formats. The Office Action also relies on col. 7, lines 48-54 in Czysczewski as disclosing these recitations. However, this citation simply discloses converting scanline information to a digital representation of the data. None of these citations teach or suggest program code for automatically determining at least one document property for optimizing output and then program code for formatting the document property. Again, these citations simply disclose that the data type is changed.

Changing between data types is different from formatting properties of the document, e.g., from black/white to color as discussed in Applicant's specification on page 14, lines 1-4.

Apparently recognizing these deficiencies, the Office Action then states that "formatting inherently automatically determines and configures a document property." By relying on inherency, the Office Action is admitting that the claim recitations are not expressly shown in the cited references. Applicant agrees with this admission. However, the Office Action failed to provide any evidence to support this interpretation of the reference. Applicant respectfully traverses this position.

In order to support a rejection based upon the inherent limitations that are not expressly disclosed in a prior art reference, more than a summary statement that the recitations are inherent is required. It must be shown that the undisclosed information was known by those of ordinary skill in the art to be

present in the reference. *Rosco, Inc. v. Mirror Light Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002).

Applicant contends that the claim recitations are not inherent in the cited references or otherwise considered common knowledge to those having ordinary skill in the art. To the contrary, Czyszczewski expressly states (col. 7, lines 48-50) and shows (Figure 9D) that the user must select a document format, and says nothing of configuring a document property. Therefore, it is not inherent in Czyszczewski to automatically determine and configure a document property.

For at least the foregoing reasons claim 18 is believed to be allowable over the cited reference and Applicant respectfully requests withdrawal of the rejection of claim 18.

Claim Rejections - 35 U.S.C. 103 – Czyszczewski and Quine

The Office Action rejected claims 1-7, 11-14, and 19-23 under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski in view of U.S. Patent No. 6,782,415 to Quine (hereinafter referred to as "Quine"). Applicant respectfully traverses this rejection for the reasons stated below.

Claim 1 recites "automatically configuring at least one property of said document based on said different types of network destinations for optimizing output of said document at said different types of network destinations" (emphasis added). Czyszczewski and Quine fail to disclose at least these recitations as discussed in more detail above for claim 1. For at least the

foregoing reasons claim 1 is believed to be allowable over the cited reference and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 2-7 depend from claim 1, which is believed to be allowable. Therefore, claims 2-7 are also believed to be allowable for at least the same reasons as claim 1 and withdrawal of the rejection of claims 2-7 is respectfully requested.

Claim 11 recites "formatting said electronic document for different types of said preferred network destinations" and "automatically configuring at least one document property for optimizing output of said document by different types of said preferred network destinations" (emphasis added). Czyszczewski and Quine fail to disclose at least these recitations as discussed in more detail above for claim 18. For at least the foregoing reasons claim 11 is believed to be allowable over the cited reference and Applicant respectfully requests withdrawal of the rejection of claim 11.

Claims 12-14 depend from claim 11, which is believed to be allowable. Therefore, claims 12-14 are also believed to be allowable for at least the same reasons as claim 11 and withdrawal of the rejection of claims 12-14 is respectfully requested.

Claims 19-23 depend from claim 18, which is believed to be allowable as discussed above with regard to the Section 102 rejection. Therefore, claims 19-23 are also believed to be allowable for at least the same reasons as claim 18 and withdrawal of the rejection of claims 19-23 is respectfully requested.

Claim Rejections - 35 U.S.C. 103 – Czyszczewski, Quine, and Daniels

The Office Action rejected claims 8-10, 15-17, 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski in view Quine and further in view of U.S. Patent No. 6,343,327 to Daniels, Jr. et al. (hereinafter referred to as "Daniels"). Applicant respectfully traverses this rejection for the reasons stated below.

Claims 8-10 depend from claim 1, which is believed to be allowable as discussed above for the Section 103 rejection in view of Czyszczewski and Quine. Therefore, claims 8-10 are also believed to be allowable for at least the same reasons as claim 1 and withdrawal of the rejection of claims 8-10 is respectfully requested.

Claims 15-17 depend from claim 11, which is believed to be allowable as discussed above for the Section 103 rejection in view of Czyszczewski and Quine. Therefore, claims 15-17 are also believed to be allowable for at least the same reasons as claim 11 and withdrawal of the rejection of claims 15-17 is respectfully requested.

Claims 24-25 depend from claim 18, which is believed to be allowable as discussed above with regard to the Section 102 rejection. Therefore, claims 24-25 are also believed to be allowable for at least the same reasons as claim 18 and withdrawal of the rejection of claims 24-25 is respectfully requested.

Conclusion

The Applicant respectfully requests that a timely Notice of Allowance be issued in this matter.

Respectfully Submitted,

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